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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,983	01/17/2002	John F. Carver	1823.0440001	3238

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EXAMINER
JEFFERY, JOHN A

ART UNIT	PAPER NUMBER
3742	

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/047,983	CARVER ET AL.	
	Examiner	Art Unit	
	John A. Jeffery	3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6, 8, and 11-13 are rejected under 35 USC 102(b) as being anticipated by EP785750. *See* transparent electric heater layer 7 and control means responsive to sensed temperature detected by thermocouple 11 in Fig. 1. *See also* col. 3, lines 12-52.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 3, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP785750 in view of JP1-205392. The claims differ from the

previously cited prior art in calling for the heater to be coupled to an adjacent surface of the electro-optic biometric image capturing device to indirectly heat the object receiving surface. Providing an electric heater on a surface adjacent to a biometric object receiving surface to indirectly heat the same is conventional and well known in the art as evidenced by JP1-205392 noting electric heater 15 disposed on prism surface R adjacent to receiving surface T in Fig. 1. In view of JP1-205392, it would have been obvious to one of ordinary skill in the art to provide an electric heater on an adjacent surface to indirectly heat the receiving surface in the previously described apparatus in order to minimize heating of the object placed on the receiving surface, thereby preventing overheating. With regard to claim 3, no criticality is seen in the control system being within the power source in lieu of separate components as disclosed by EP785750. Furthermore, it is well settled that the recitation that a structure is integral, as contrasted to constituent parts which are rigidly secured together, is merely a matter of obvious engineering design choice. See *In re Fridolph*, 50 CCPA 745, 89 F.2d 509, 135 USPQ 319. See also *In re Lockhart*, 90 USPQ 214 (CCPA 1951), *In re Larson*, 144 USPQ 347, and *Howard v. Detroit Stove Works*, 150 US. 164 (1893). Regarding claim 9, the use of copper and silver for conductive materials is conventional and well known in the art in view of their excellent electrical conductivity and their use does not constitute a patentably distinguishable characteristic of the invention. Regarding claim 10, the use of translucent pads coupled to opposite edges of a heater film is conventional and well known in the art and does not constitute a patentably distinguishable characteristic of the invention.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP785750 in view of Maase (US5825474). The claims differ from EP785750 in calling for the step of removing additional moisture with the heater. EP785750 in col. 2, lines 14-21 states that the purpose of the electric heater is to increase sweat production to improve optical coupling to the surface. While admittedly the purpose of EP785750 is to increase moisture generation from the user's finger, the examiner notes that, given its operating temperature, the electric heater of EP785750 would inherently remove any undesired excess moisture from the platen which would inhibit proper imaging. Notwithstanding the inherent moisture inhibiting properties of the EP '750 heater, the use of electric heaters in conjunction with finger-receiving surfaces to inhibit excess moisture thereon is conventional and well known in the art as evidenced by Maase (US5825474) noting the last line of the Abstract wherein the skin receiving surface is maintained within a selected temperature range to inhibit condensation of moisture from the subject's fingers onto the finger-receiving surface. In view of Maase (US5825474), it would have been obvious to one of ordinary skill in the art to use the heater of EP785750 to inhibit excess moisture from collecting on the finger-receiving surface of the previously described apparatus so that excess moisture was prevented thereby improving imaging.

Claims 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP1-205392 in view of Auerswald et al (US5946135). The claims differ from JP1-

205392 in calling for first and second heaters coupled to first and second prism ends respectively. While only a single electric heater is attached to the prism in JP1-205392, the use of multiple electric heaters attached to separate ends of a prism to separately heat the respective end is conventional and well known in the art as evidenced by Auerswald et al (US5946135) noting independent electric heaters 8-10 in Fig. 3 which heat separate ends of the prism independently. The independent heating of different prism surfaces facilitates the separate control of each heater's zone independent of the other. *See* col. 2, lines 50-56. In view of Auerswald et al (US5946135), it would have been obvious to one of ordinary skill in the art to provide independent electric heaters for ends of the prism of JP1-205392 so that separate prism surfaces could be heated independently thereby facilitating a desired heating profile along the prism--either a heating gradient or a uniform heating profile. Regarding claim 19, no criticality is seen in the specific heating control paradigm of three discrete power levels in view of Applicant's own admission in the instant specification on Page 13, paragraph 55 that other thresholds could be used or even eliminated entirely.

Response to Arguments

Applicant's arguments filed have been considered but are not deemed to be persuasive.

The 102(b) Rejection

Applicant argues that because the apparatus of EP 785750 does not eliminate the "halo effect," it is different from the instant invention which generates heat to

eliminate excess moisture. However, Applicant's arguments are not commensurate with the scope and breadth of the claims. While Applicant's remarks concerning the desirability of the apparatus to eliminate the "halo effect," the examiner first notes that the claims rejected under 102(b) are apparatus claims -- not method claims-- and the scope and breadth of the structure recited is fully met by EP785750.

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970).

Here, the claims merely called for "a transparent conductive film." Such a "transparent conductive film" is fully met by transparent film 7 of EP785750. A power source 9 is coupled to the film via a pair of conductors on respective edges. Applicant's arguments regarding the elimination of moisture and the halo effect essentially highlight the intended use of the apparatus structure--not the structure itself which is the focus of the patentability analysis for apparatus claims. It is well settled that a recitation of the intended use of the claimed invention must result in a structural

difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Also, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of the apparatus claimed. See *Ex parte Masham*, 2 USPQ 2d 1647 (1987). Here, the structure of EP785750 is capable of performing the claimed intended use--enhancing biometric image capture. The claims are fully met by EP785750.

The 103(a) Rejections of the Apparatus Claims

Regarding claims 3,7,9, and 10, Applicant argues that there is allegedly no motivation to combine EP785750 and the secondary reference to JP1-205392. Applicant takes the position that because the JP1-205392 prism raises the temperature, it would increase sweating and thus moisture on the prism; however, the instant invention decreases moisture. However, here again, Applicant's arguments are more appropriately directed to the apparatus' intended use--not its structure. As noted above, if the prior art structure is capable of performing the intended use, then it meets the claim. Here, as above, the heated platen structure of the combination of EP '750 and JP '392 is capable of performing the intended use--namely, "enhancing biometric image capture." Additionally, as noted in the rejection, the teaching of indirectly heating the receiving surface is amply demonstrated by JP '392 so that the object placed on the

heated surface is more gently heated thereby avoiding undesired overheating. Moreover, no criticality is seen in the use of silver and copper conductive materials. As noted in the rejection, copper and silver are well known in the art for their excellent electrical conductivity. Also, translucent pads in transparent electric heaters are commonly used to provide electrical connections to transparent resistive areas in order to blend with the remainder of the transparent structure. The examiner's *prima facie* case of obviousness is proper.

The 103(a) Rejections of the Method Claims

Regarding claims 14 and 15, the examiner notes that these claims are, in fact, method claims. The examiner notes the heater of EP '750 would inherently remove additional moisture form the platen by virtue of its operating temperature, given the broadest reasonable interpretation of the limitation "additional moisture near a biometric object to be imaged...to prevent a halo effect."

But even if, for the sake of argument, the heater of EP '750 could somehow not inherently remove this additional moisture, the teaching of Maase provides a strong suggestion to one of ordinary skill in the art to remove such moisture to inhibit the halo effect. Indeed, Maase uses an electric heater for just that purpose. See col. 3, lines 13-15 and 26-30.

Applicant takes the position that because Maase does not teach heating the finger during imaging, then heating to reduce the halo effect during imaging would allegedly not be obvious to one of ordinary skill in the art. But, the base reference to EP

'750 does teach heating during imaging. Moreover, the secondary Maase reference touts the advantages of maintaining the receiving surface at a certain temperature for the very reason as the instant invention--to reduce the halo effect. One of ordinary skill in the art would readily be capable of operating the electric heater of EP '750 in accordance with the suggestion of Maase to achieve the desired results--namely reducing the halo effect by maintaining the platen surface at a given temperature.

The Auerswald Reference

Applicant's arguments with regard to Auerswald are noted, but but the reference was cited merely for the teaching of independently heating different surfaces of a prism independently. Unlike using a single heater to heat a prism, a multiple heater array with heaters on each surface enables independent heating of each surface thereby facilitating a desired heating profile along the prism--either a heating gradient or a uniform heating profile. The fact that the prism of Auerswald is not expressly stated for use in an imaging device was not a factor in the reason the reference was cited. One of ordinary skill in the art would reasonably rely on the teachings of Auerswald when confronted with the problem of heating a prism to achieve a desired heating profile along the prism. The art is analogous and the rejection is proper.

Other Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The art should be both separately considered and considered in

conjunction with the previously cited prior art when responding to this action. SU 854 discloses a heated imaging system relevant to the instant invention.

FINAL REJECTION

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

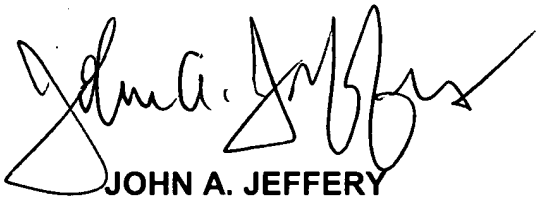
Conclusion

Any inquiry concerning this or earlier communications from the examiner should be directed to John A. Jeffery at telephone number (703) 306-4601 or fax (703) 305-3463. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 4:30 PM EST. The examiner can also be reached on alternate Fridays.

The fax phone numbers for the organization where this application or proceeding is assigned are:

Before Final	(703) 872-9302
After Final	(703) 872-9303
Customer Service	(703) 872-9301

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0861.



JOHN A. JEFFERY
PRIMARY EXAMINER

3/7/03